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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,392	12/21/2001	Selvakumar Natesan	U 013775-0	5457

7590
Ladas & Parry
26 West 61 Street
New York, NY 10023

10/19/2004

EXAMINER

SHAMEEM, GOLAM M

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/032,392		SELVAKUMAR NATSAN	
	Examiner		Art Unit	
	Golam M M Shameem		1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-20,31-38 and 41-51 is/are pending in the application.
- 4a) Of the above claim(s) 8-20,32-34,36-38,47,48,50 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,31,35,41-46 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

This application claims benefit for foreign priority under 35 U.S.C. § 119(a)-(d) to India 1124/MAS/2000 12/26/2000 is also acknowledged.

Information Disclosure Statement

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 08/04/2004, which has been entered in the file.

Status of Claims

Claims 1, 2, 4-20, 31-38 and 41-51 are pending in the application. Claims 3, 21-30, 39-40 were canceled previously.

Receipt is acknowledged of amendment / response filed on July 12, 2004 and that has been entered.

Claims 8-20, 32-34, 36-38, 47, 48, 50 and 51 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

Response to Election/Restriction

In response to the restriction requirement, Applicants have elected Group I, which includes claims 1-2, 4-7, 31, 35, 41-46 and 49 drawn to a compound and composition, and the elected compound as set forth (Remarks, page 2) with traverse is acknowledged. The traversal is on the ground(s) that "all of the claims should be examined" with the elected Group I because a search and examination of the entire Markush group should be made without serious burden on the Examiner.

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The Examiner respectfully disagrees with the Applicants because the products of groups I-VI differ materially in structure and in element from each other and therefore, are capable of supporting their own patents. The invention groups I-VI are related to a set of structurally diverse compounds, process of making and their methods of uses (chemical structures, which are similar, are presumed to function similarly, whereas chemical structures that are not similar are not presumed to function similarly), which do not possess a substantial common core wherein a reference anticipating one would not necessarily render the other obvious and to search all the above groups in a single application would be an undue burden on the Examiner. Because of the plethora of classes and subclasses in each of the Group, a separate search considerations are involved, which would impose a serious burden on the Examiner to perform a complete search of the defined areas if unrestricted. Also the fields of search are not coextensive. The wide disparity among the groups requires that many divergent fields must be searched, including all classes and subclasses of U.S. and foreign patents as well as journals and publications. However, Examiner may reconsider to rejoin method of use claims commensurate in scope with the product claims when the case would be found in condition for allowance [provided those method claims are free from 35 U.S.C. §112 first (including written description, reach-through claim language and/or scope-enablement issues) and second paragraphs]. For these reasons, Applicant's arguments are found unpersuasive and, therefore, the requirement for restriction and election of species is still deemed proper.

Applicants preserve their right to file a divisional on the non-elected subject matter.

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As set forth in the restriction requirement and an election of a single compound (or set of compounds), the invention will encompass all compounds that fall within the scope of the claim is as follows:

A compound having the formula in claim 1 wherein:

R^1 is as claimed except R^4 can not be "hydrogen",

R^2 and R^3 are as claimed,

Z represents O,

Y^1 is as defined,

Y^2 and Y^3 are as claimed except both cannot be "independently hydrogen" or any other hetero substitutions such as "heteroaryl".

As a result of the election and the corresponding scope of the compound identified, claims 8-20, 32-34, 36-38, 47, 48, 50 and 51 and the remaining subject matter of claims 1-2, 4-7, 31, 35, 41-46 and 49 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 8-20, 32-34, 36-38, 47, 48, 50 and 51 is properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct there from.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-7, 31, 35, 41-46 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun *et al* (1979). Applicant claims heterocyclic compounds having antibacterial activity.

Determination of the scope and content of the prior art (MPEP §2141.01)

Braun *et al* teach a series of structurally similar oxazolidinone derivatives and process of preparation thereof.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

Broadly, the compounds taught by Braun *et al* are similar of instantly claimed compounds. Braun *et al* teach substituted oxazolidinone (RN 69974-32-9, RN 69974-33-0, RN 69974-34-1 CAPLUS data base, all provided herewith), wherein R¹ is OR⁴ where R⁴ is hydrogen, R² and R³ are hydrogen, Z is O, Y¹ is =O, Y² is hydrogen and Y³ is aryl (phenyl) or hydroxyl alkyl. The differences between the instant claims and that of the prior art reference are so negligible (floating variables of Y² and Y³ versus fixed substitutions), that one of ordinary skill in the chemical arts would expect slight modifications / variations to be within the expected purview of 35 U.S.C. 103(a). The disclosure of Braun *et al* that teach several combinations, which would easily place Applicants invention in possession of the public at the time of Applicants invention, was filed.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

It would have been prima facie obvious to one having ordinary skill in the art at the time of the invention was made since Braun *et al* teach compounds which are generic to the claimed compounds. Thus one having ordinary skill in the chemical art would be motivated to employ the

prima facie positional substitution variations (having a substitution at the 5th position or any other desired position) of core oxazolidin-2-one ring to modifying the prior art compound since one would have reasonable expectation that such modification would make similar compounds and expected to possess similar properties differing only in degree in view of the known teaching of the art. The instantly claimed compounds are so closely related structurally to the analogous / homologous compounds of the reference as to be structurally obvious therefore in the absence of any unobviousness or unexpected properties. Since the core oxazolidin-2-one ring of formula (I) is not novel and the novelty (if there is any) belongs to the selection of different variable substitutions, a great caution should be exercised to determine the patentability of the claimed invention. Therefore, in looking at the instant claimed compounds as a whole, the claimed compounds would have been suggested to one skilled in the art unless unobvious or unexpected results can be shown.

Objections

Claims 1-2, 4-7, 31, 35, 41-46 and 49 are objected to for containing non-elected subject matter. The claims should be amended to exclude non-elected subject matter and within the scope of elected compound.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone

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number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mcKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read "Golam M M Shameem". The signature is stylized with a large, looping initial "G" and a cursive script for the rest of the name.

Golam M M Shameem, Ph.D.
Patent Examiner
Art Unit 1626, Group 1600
Technology Center 1

October 12, 2004